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FAX COVER SHEET

Date	4/18/2003
Total Number of Pages	(Including this page) 29
To	Mr. Scott E. Jones (Group Art # 3713)
Company	Commissioner for Patents
City	Washington, D.C.
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Phone Number	703 – 308 – 7133
From	Robert J. Buccieri
	Intellectual Property Department Administrator
Direct Dial Phone	312 558-8279
Client/Matter Number	112300-722
Document Description	U.S. Serial No. 09/934,003

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GROUP 3700

Message

Dear Mr. Jones:

    Pursuant to your telephone message of 4/18/2003, attached for **PROOF OF TIMELY FILING OF RESPONSE** is:

1) Copy of stamped postcard dated 1/15/2003 showing receipt of Response to Office Action (1 page)
2) Copy of Express Mail Receipt with "Date In" of 1/15/2003. (1 page)
3) Copy of Certificate of Express Mailing – EV 110954194US (1 page)
4) Copy of Amendment Transmittal Letter (Large Entity) (2 pages)
5) Copy of Response to Office Action of 10/17/2002. (23 pages)

Please call with if there is anything else needed for this application to move forward.

Thank you for your attention to this matter.

                                      Robert J. Buccieri

        Intellectual Property Departments direct fax no. 312-807-4240.

If this transmission is incomplete, please call 312 558-8279.

In re Patent Application of: Anthony J. Baerlocher et al.
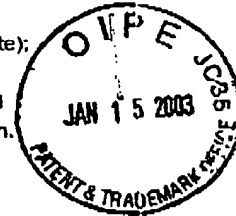
**GAMING DEVICE HAVING PLAYER SELECTABLE AWARD
DIGITS AND AWARD MODIFICATION OPTIONS**

Docket No.: 0112300-722   Appl. No.: 09/934,003
                          Filing Date: August 20, 2001

On the date stamped hereon the U.S. Patent & Trademark Office hereby
acknowledges the receipt of the following:

1.   Amendment Transmittal Letter (Large Entity) (Duplicate);
2.   Response to Office Action (23 pages);
3.   Certificate of Express Mail (EV 110 954 194 US); and
4.   A postcard which we ask you to date stamp and return.

    Mailed on: January 15, 2003 (AHM)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Anthony J. Baerlocher et al.
Appl. No.:   09/934,003
Filed: August 20, 2001
Title: GAMING DEVICE HAVING PLAYER SELECTABLE AWARD DIGITS AND
               AWARD MODIFICATION OPTIONS
Art Unit: 3713
Examiner: S. Jones

Docket No.:   0112300-722

Commissioner for Patents
Washington, DC 20231

CERTIFICATE OF MAILING BY EXPRESS MAIL UNDER 37 CFR 1.10

Sir:

I hereby certify that the following documents relating to the above-identified application:

1. Amendment Transmittal Letter (Large Entity) (Duplicate);
2. Response to Office Action (23 pages); and
3. A postcard which we ask you to date stamp and return.

are being deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to:

Commissioner for Patents
Washington, DC 20231

on January 15, 2003.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

Robert Brociori
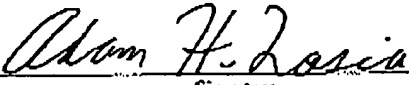Name of Person Mailing Correspondence

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1

AMENDMENT TRANSMITTAL LETTER (Large Entity)

	Docket No.
Applicant(s): Anthony J. Baerlocher et al.	0112300-722

Serial No.	Filing Date	Examiner	Group Art Unit
09/934,003	August 20, 2001	S. Jones	3713

Invention: **GAMING DEVICE HAVING PLAYER SELECTABLE AWARD DIGITS AND AWARD MODIFICATION OPTIONS**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

CLAIMS AS AMENDED

	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	50 -	50 =	0	x $18.00	$0.00
INDEP. CLAIMS	7 -	7 =	0	x $84.00	$0.00
Multiple Dependent Claims (check if applicable) ☐					$0.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					$0.00

☒ No additional fee is required for amendment.

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   ☒ Any additional filing fees required under 37 C.F.R. 1.16.

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Dated: January 15, 2003

Signature

Adam H. Masia (Reg. No. 35,602)
BELL, BOYD & LLOYD LLC
P. O. Box 1135
Chicago, Illinois 60690

CC:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Anthony J. Baerlocher et al.
Appl. No.: 09/934,003
Filed: August 20, 2001
Title: GAMING DEVICE HAVING PLAYER SELECTABLE AWARD DIGITS
       AND AWARD MODIFICATION OPTIONS
Art Unit: 3713
Examiner: S. Jones
Docket No.: 0112300-722

Honorable Commissioner for Patents
Washington, DC 20231

RESPONSE TO OFFICE ACTION

Sir:

In response to the Office Action dated October 17, 2002, please enter this Response in the above-identified patent application.

In the Specification:

Please replace the paragraph beginning page 16, line 6, with the following rewritten paragraph:

Referring now to Figs. 3A and 3B, the game displays three selectable selections or masked numbers 116, namely, the "X," "Y" and "Z" selections or masked numbers 116. The selections or masked numbers 116 illustrated generally on the screen 130, as well as other inputs and indicators, preferably contain indicia that relate to a theme of the gaming device. The selections or masked numbers 116 hide numbers or digits that are revealed and become part of the player's award. That is, the player's award is based on the order of numbers or digits associated with the selections or revealed when the masked numbers are unmasked. For purposes of this application, "selections" and "masked numbers" are used interchangeably.

Please replace the paragraph beginning page 27, line 23, with the following rewritten paragraph:

The screen 145 can present any number of selectable inputs, such as inputs 102 through 108, and is not limited to presenting four as illustrated. The selectable inputs in one embodiment are areas of a touch screen 50 (see Fig. 2) in communication with the processor 38 and a touch screen controller 52. The inputs may alternatively be separate electromechanical input devices, mounted elsewhere on gaming device 10, which are in communication with the processor 38. A message 110 is visually displayed, audibly displayed through speakers 36 or both.

In the Claims:

Please amend Claim 1 as follows:

1.   (Amended) A gaming device comprising:

a display device;

a plurality of player selectable positions displayed by the display device; and

a processor which communicates with the display device, which enables a player to select the positions, which associates numbers with the positions based on the player's order of selection of the positions and which determines an award to be provided to the player based on an order of the numbers associated with the positions.

2

Appl. No. 09/934,003

Please amend Claim 12 as follows:

12.   (Amended) A gaming device comprising:

a display device;

a plurality of masked numbers displayed by the display device;

a processor which communicates with the display device and enables a player to arrange at least two of the masked numbers in an order decided by the player; and

an award determined by the processor and provided to the player, wherein the amount of the award is based on the order of the masked numbers arranged by the player.

Please amend Claim 30 as follows:

30.   (Amended) A gaming device comprising:

a display device;

a plurality of positions;

a plurality of selections displayed by the display device; and

a processor which communicates with the display device, which associates a plurality of numbers with the selections, which enables a player to associate the selections with the positions, which causes the display device to display the numbers of the selections associated with the positions, and which provides an award to the player, wherein the amount of the award is based on the digit order of the numbers associated with the positions.

3

Appl. No. 09/934,003

Please amend Claim 49 as follows:

49.   (Amended) A gaming device comprising:

an initial determination of a number of possible digits for a player's award;

a display device;

a plurality of selections displayed by the display device; and

a processor which communicates with the display device, which associates numbers with the selections, and which enables the player to associate the selections with the number of possible digits provided by the initial determination to form an award provided to the player wherein the amount of the award is based on the order of the digits.

4

REMARKS

This Response is submitted in reply to the Office Action dated October 17, 2002. Claims 1, 12, 30 and 49 have been amended. The specification has been amended for reasons of clarification only and not for any substantive reason of patentability under 35 U.S.C. §§ 101, 102 and 103. No new matter has been added by any of the amendments made herein. No fee is required. Please charge Deposit Account No. 02-1818 for any insufficiency or to credit any overpayment.

As a preliminary matter, the Patent Office objected to the drawings under 37 C.F.R. § 1.84(p)(5) because the drawings and specifically, Figs. 3A and 3B, do not include reference numeral 100 which is mentioned in the specification. Applicants have amended the specification to remove reference numeral 100. Accordingly, it is respectively submitted that rejection should be withdrawn.

Claims 1, 4, 5, 12 to 14, 17 to 22, 30 to 37, 42 to 44 and 46 to 50 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,695,053 to Vasquez, Jr. et al. ("*Vasquez*"). Claims 1, 2, 4, 5, 12 to 16, 21, 30 to 36, 42 to 44 and 47 to 50 were rejected under 35 U.S.C. § 102(b) as being anticipated by any one of the Price is Right's pricing games: Any Number, Cover Up, Dice Game, Easy as 1, 2, 3, Grand Game, Line em' Up, Side by Side, Squeeze Play, Switcharoo, Temptation, Ten Chances, Master Key, Money Game, One Away, Pathfinder, Pick a Number or Lucky Seven. Claims 3 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Vasquez* and in further view of U.S. Patent No. 5,205,555 to Hamano ("*Hamano*"). Claims 6 to 11, 23 to 28 and 38 to 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Vasquez* and in further view of the Take Your Pick game ("*Take Your Pick*"). Claim 45 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Vasquez*. Applicants respectfully disagree with and traverse these rejections. To place the application in condition for allowance, Applicants have amended the claims to clarify the claimed invention and not for purposes of adding further elements to distinguish over the above references used in the Office Action to reject the claims.

5

Amended Claim 1 is directed to a gaming device including a display device and a processor which communicates with the display device. The gaming device includes a plurality of player selectable positions displayed by the display device. The processor enables a player to select the positions displayed by the display device. The processor associates numbers with the positions based on the player's <u>order</u> of the selection of the positions and determines an award to be provided to the player based on an order of numbers associated with the positions.

For example, under the invention of amended Claim 1 the processor selects a number from a plurality of numbers, such as the number nine, and associates that number with the first position selected by the player. If the first position selected by the player is the ten's position in a three-digit number, then the processor associates the number nine with the ten's position. The processor then selects another number and associates that with the next position selected by the player such as the hundred's position. The processor continues to select numbers and associate the selected numbers with each position picked by the player until there are no positions remaining to select. <u>Thus, the order that the player picks the positions determines the position (i.e., place) of the numbers selected and associated by the processor.</u> The award is based on the order of the numbers associated with the positions.

Claim 1, as amended, is patentably distinguished over *Vasquez* because *Vasquez* does not disclose all of the elements of Claim 1. *Vasquez* discloses a gaming device that enables a player to pick a winning sequence or combination of numbers in a game. Specifically, the player selects numbers for each of the reels 12, 14 and 16 using the digit indicators 34 on display 36. See Col. 3, lines 12-15. The numbers are selected by the player by inputting or pressing the keys on keyboard 28. Once a number is inputted for a particular digit 34, the player moves to the next digit and inputs another number. The player may input a number between zero and nine and may change the numbers for the digits as desired. See Col. 3, lines 28-32. Once all the digits have been selected, the player initiates the activation of the reels by pulling the handle 20. If the pre-determined winning symbol combination or the number sequence entered by the player occurs on win line 22, the gaming device provides an award to the player. *Vasquez*, however, does <u>not</u> disclose a processor which associates

6

numbers with the positions or digits in display 36 based on the order of selection of the positions or digits by the player. Instead in *Vasquez*, the gaming device associates numbers with the digit indicators 34 based on the numbers inputted by the player. Thus, the order in which the player inputs the numbers into the digit indicators is not relevant to which number the gaming device associates with each of the digit indicators.

Additionally, *Vasquez* does not teach or suggest providing an award to a player which is based on the order of numbers associated with the positions as in Claim 1. *Vasquez* discloses providing a separate award to the player independent of the number indicated by the digit indicators 34. The award is based on the number of matching numbers between the digit indicators (i.e., the player selected numbers) and the numbers indicated on the reels 12, 14 and 16. (Col. 5, lines 44-50). Therefore, *Vasquez* does not disclose, teach or suggest providing an award that equals the value of the number indicated by the digit indicators 34.

Therefore, *Vasquez* does not disclose all of the elements of Claim 1. For at least these reasons, independent amended Claim 1 and Claims 2 through 11, which depend from Claim 1, are each patentably distinguished over *Vasquez*.

Amended Claim 1 is also patentably distinguished over all of The Price is Right's pricing games cited by the Patent Office. The Price is Right's pricing games generally disclose games in which players attempt to guess a predetermined price or prices for particular prizes. The positions or digits of the prices are predetermined and assigned to the positions in the prices. The player then plays a particular type of game to determine the numbers in the positions in the price or prices. Therefore, contrary to the claimed invention, the Price is Right's pricing games do not associate numbers with the positions in the prices based on the order of the selections of the positions by the player.

Moreover, the Price is Right's pricing games generally disclose games in which a player attempts to guess the exact price of a prize item. If the player unsuccessfully guesses the price of a prize by the end of a game, the player does not win a prize based on the order of the numbers. Instead the player wins a lesser prize or no prize at all. Furthermore, if the player does guess the price of a prize, the player does not win the value indicated by the price but instead, the player wins the prize itself. This is

7

contrary to the present invention wherein the gaming device awards the value of the number formed by the order of the numbers associated by the player with the positions. For example, if a player picks the positions and the number formed by the digits in those positions is 9-0-5, the gaming device awards the player an award having an amount of nine hundred five. If the player picks the positions and the number formed by the digits in the positions is 0-9-5, the gaming device awards the player an award of ninety-five. Conversely, the Price is Right pricing games provide the prize associated with the price guessed by a player and not the actual value of the numbers which form the price.

Specifically, in the *Any Number* game, the game displays three prizes having associated masked prices for each of the prizes. The game enables a player to pick a digit or number from zero to nine and that digit is revealed in one of the prices associated with three prizes. The prices are predetermined and therefore the numbers or digits associated with those prices are assigned to the positions before the player picks any of the digits in the prices. Contrary to the claimed invention, the player does not pick the positions in the prices nor does the game associate the numbers picked by the player with the positions in the prices based on the order of selection of the positions by the player. Therefore, the *Any Number* game does not disclose, teach or suggest all of the elements of the claimed invention.

In the *Cover-Up* game, the price of a car is displayed to a player. However, the price is wrong and the player must guess the correct price of the car by picking one number from a set of numbers associated with each of the digits in the price of the car and cover the incorrect digits with the selected numbers. The game enables the player to continue to pick numbers until the player determines the correct price or until the player gains no new correct digits in an attempt. In this game, the player is not picking the positions in the price of the car nor is the processor associating any numbers picked by the player with the digits in the price of the car based on the order of the digits or positions picked by the player. Thus, *Cover-Up* does not disclose, teach or suggest all of the elements of claimed invention.

In the *Dice Game*, a player attempts to guess the price of a car by rolling a die to obtain the digits in the price of the car. The player rolls a die and if the number

8

indicated on the die is not the actual number in the first position or digit of the price, the player picks whether the actual number in the price is higher or lower than the number indicated on the die. The player repeats this process until all of the digits or positions in the price are picked. The price of the car is predetermined prior to the player rolling the die and indicating any numbers in the price. Also, the gaming device does not enable the player to pick any of the positions in the price of the car. Furthermore, if the player's price does not match the price of the car, the player does not win the car. Thus, the *Dice Game* does not disclose a processor which enables the player to select positions in the price, associate numbers with the order of the positions selected by the player or teach or suggest such elements or features.

The *Easy as 1, 2, 3* game discloses a game in which a player is given three blocks labeled 1, 2 and 3. The player places block 1 in front of the prize having the least expensive price, block 2 in front of the prize having the second most expensive price and block 3 in front of the prize having the most expensive price. The player wins all of the prizes if the order is correct. This game does not disclose assigning numbers to particular positions. The prices are predetermined based on the actual price of the prizes and the player is only guessing the value of each of those prices. Furthermore, the player is not selecting the positions in the prices nor is the gaming device assigning numbers based on the order of the positions selected by the player in the prices. Thus, the *Easy as 1, 2, 3* game does not disclose, teach or suggest all of the elements of the claimed invention.

The *Grand Game* discloses a game in which a player picks products which have prices below a predetermined target price to earn digits in a predetermined cash prize of ten thousand dollars The prize initially starts at one dollar and a zero is added to the prize for each product selected by the player having a price below the target price. In this game, the player is not picking the positions of the digits in the cash prize nor is the gaming device assigning or associating numbers with the positions in the cash prize based on the order of any positions selected by the player. Contrary to the claimed invention, the *Grand Game* does not disclose any player selectable positions or associate numbers with the positions based on the order selection of the positions by

9

the player. Thus, the *Grand Game* does not disclose, teach or suggest all of the elements of the claimed invention.

The *Line 'Em Up* game discloses a game in which a player attempts to guess the price of a car. The game enables the player to use digits in the prices of three prizes to determine the price of the car. The player is able to slide the prices of the prizes to align one of the digits or numbers in the prices in the price of the car. If the aligned digits in the price matches the corresponding designated digits in the correct price of the car, the player wins the car. Therefore, the digits in the price of the car are predetermined based on the actual price of the car and are not determined by the numbers associated with the positions in the price by the player. If any one of the digits selected by the player do not match the corresponding digit in the price of the car, the player does not win the car or the value of the number indicated by the correctly selected digits. Moreover, the order in which the player selects the digits in the price of the car is not important. Thus, the *Line 'Em Up* game does not disclose, teach or suggest all of the elements of the claimed invention.

In the *Side-by-Side* game, the player attempts to determine a price of a prize using two two-digit numbers. The player arranges the two two-digit numbers to equal the price of the prize. If the arranged price matches the actual price of the prize, the player wins the prize. Therefore, the gaming device does not associate numbers with the positions in the price of the prize based on the player's order of selection of the positions in the price. In fact, the player is not selecting the positions in the price of the prize, but instead, is arranging two-digit numbers to match the price of the prize. Thus, the *Side-by-Side* game does not disclose, teach or suggest all of the elements of the claimed invention.

The *Squeeze Play* game discloses a game in which a prize includes a price including five digits is displayed to a player. One of the digits in the price is incorrect and the player must choose the incorrect digit and remove it from the price. The remaining digits are squeezed together and if those digits form the actual or correct price of the prize, the player wins that prize. Again, the price of the prize is predetermined and therefore the gaming device does not assign or associate numbers with the positions or digits in the price of the prize based on the order of selection of

10

Appl. No. 09/934,003

positions by the player. Also, the player is merely selecting one digit in the price and not any of the positions in the price. Thus, the *Squeeze Play* game does not disclose, teach or suggest all of the elements of the claimed invention.

The *Switcharoo* game discloses a game in which five prizes are displayed to a player and each prize includes a predetermined price. The price associated with each prize is missing a digit. The player is given five blocks including the missing digits in the prices of the prizes and must fill in the missing spaces in the prices with those blocks. The player wins the prizes having the correct prices. As described above, the prices of the prizes are predetermined and the player is merely selecting one digit in each price of the prizes. The player is not selecting the positions in the prizes nor is the gaming device associating numbers with any positions selected by the player in the prices. Thus, the *Switcharoo* game does not disclose, teach or suggest all of the elements of the claimed invention.

In the *Temptation* game, a player attempts to determine the price of a car. The game enables the player to choose the digits in the price of the car from the prices of other prizes displayed to the player. The player wins the car if they correctly place the missing digits in the price of the car. In this game, the price of the car is predetermined and therefore a number is pre-assigned or pre-associated with each position in the price of the car. The positions in the price of the car are actually assigned or associated numbers based on the numbers picked by the player from the other prices. The order of selection of the positions does not determine the numbers associated with those positions. Therefore, the *Temptation* game does not disclose, teach or suggest all of the elements of the claimed invention.

The *Ten Chances* game discloses a game in which a player is shown three prizes and must guess the price of each of the prizes. The player writes the price of the prizes next to the masked price of the prize and gets ten chances to write in the correct prices for all three prizes. The player wins the prizes having the correct price. Again, the prices of the prizes are predetermined and therefore the gaming device is not associating numbers with the positions in the prices based on the order of the numbers written down by the player. The player is also not selecting the positions of each of the prizes, but instead is selecting numbers to match the numbers in the positions of the

11

prices. Thus, the *Ten Chances* game does not disclose, teach or suggest all of the elements of the claimed invention.

The *Master Key* Game discloses a game in which a player selects the first or last two digits in a set of prices for prizes displayed to the player. If the player correctly chooses the two digits in the price of a prize, the player wins the prize and a key associated with the prize. The player wins additional prizes unlocked by the keys. In this game, the price of the prizes are predetermined and therefore the gaming device is not assigning or associating numbers with any positions in the prices selected by the player. Therefore, the *Master Key* Game does not disclose, teach or suggest all of the elements of the claimed invention.

In the *Money Game*, nine two-digit numbers are displayed to the player wherein the player arranges the two-digit prices to form the prices of prizes displayed to the player. The player wins the prizes having the correct prices. Again, the prices of the prizes in this game are predetermined and therefore, the gaming device is not associating numbers or digits with the positions in the price of the prizes based on the order of selection of the positions in the prices by the player. In fact, the player is not selecting any positions in the prices. Thus, the *Money Game* does not disclose, teach or suggest all of the elements of the claimed invention.

The *One Away* Game discloses a game in which the player is shown all of the digits in the price of a car. However, the digits are each one away from the actual digits in the price of the car. The player selects either the digit that is higher or lower than each of the displayed digits in the price of the car to determine the correct price of the car. If the player selects all of the correct digits in the price of the car, the player wins the car. In this game, the price of the car is predetermined and therefore the gaming device is not assigning or associating numbers in the positions in the price of the car based on the order of the positions selected by the player. Additionally, the player is not selecting any of the positions in the price of the car, but instead, is selecting the numbers associated with the positions in the price of the car. Thus, the *One Away* Game does not disclose, teach or suggest all of the elements of the claimed invention.

The *Pathfinder* game discloses a game in which a player attempts to determine the price of a car by stepping on squares in a grid, wherein each square includes one of

12

the digits in the price of the car. The player wins the car if the player correctly steps on the grids which form the price of the car. Again in the *Pathfinder* game, the price of the car and thereby the numbers in the price of the car are pre-associated with the positions or digits in the price. Therefore, the numbers in the price of the car are not associated with the positions or digits in the price based on the order of selection of the positions by the player. Also, the player selects the numbers (not the positions) associated with each position in the price. Thus, the *Pathfinder* game does not disclose, teach or suggest all of the elements of the claimed invention.

The *Pick-a-Number* game discloses a game in which a player picks one number from the prices associated with three prizes to fill in a missing number in the price of a larger prize. In this game, the price of the each of the prizes is predetermined and the numbers in the price are pre-assigned to the digits or positions in those prices. The gaming device does not associate the numbers in the price with the positions in the price based on the order of selection of the positions by the player. Additionally, the player does not select the position in the price to place the missing number. Instead, the position of the missing digit in the price is predetermined. Therefore, the *Pick-a-Number* game does not disclose, teach or suggest all of the elements of the claimed invention.

In the *Lucky Seven* game, a player receives seven one dollar bills at the beginning of the game and must guess the digits in the price of a car. A player then gives away a dollar for each number that the player is away from the actual numbers or digits in the price of the car. The player wins the car if they have at least one dollar remaining after picking all of the digits in the car. As described above, the price of the car is predetermined and the numbers associated with each of the positions in the price are pre-assigned to those positions. Also, the player is picking or guessing the actual digits in each of the positions instead of picking the positions in the price of the car. As a result, the processor is not associating the numbers with the positions in the price of the car based on the order of selection of the positions by the player. Therefore, the *Lucky Seven* game does not disclose, teach or suggest all of the elements of the claimed invention.

13

Appl. No. 09/934,003

For all of the above reasons, none of the Price is Right pricing games disclose all of the elements of amended Claim 1. Specifically, the Price is Right Pricing games generally do not include a plurality of player selectable positions or a processor which associates numbers with those positions based on the player's order of selection of those positions. Therefore, amended Claim 1 and Claims 2 to 11, which depend from Claim 1, are each patentably distinguished over the Price is Right pricing games.

Claim 3 was rejected under § 103(a). Claim 3 depends from amended Claim 1. Therefore, Applicants respectfully submit that Claim 3 is allowable for at least the reasons set forth above with respect to independent amended Claim 1, and for the further reasons that *Hamano* fails to disclose, teach or suggest the novel elements of this claim in combination with the novel elements of independent amended Claim 1. For these reasons, Claim 3 is patentably distinguished over the combination of *Vasquez* and *Hamano*.

Additionally, Claims 6 to 11 were rejected under § 103(a). Claims 6 to 11 depend from amended Claim 1. Therefore, Applicants respectfully submit that Claims 6 to 11 are allowable for at least the reasons set forth above with respect to independent amended Claim 1, and for the further reasons that *Take Your Pick* fails to disclose, teach or suggest the novel elements of these claims in combination with the novel elements of independent amended Claim 1. For these reasons, Claims 6 to 11 are patentably distinguished over the combination of *Vasquez* and *Take Your Pick*.

Amended Claim 12 is directed to a gaming device including a display device which displays a plurality of masked (or hidden) numbers. A processor, which communicates with the display device, enables a player to arrange at least two of the masked numbers in an order decided by the player. The gaming device provides an award to the player based on the order of the masked numbers arranged by the player. For example, if the player arranges the masked numbers and the masked numbers reveal a number of one hundred, the processor provides an award of one hundred such as one hundred credits or coins, to the player.

On the contrary, *Vasquez* discloses a game in which a player enters numbers into a display 36. Once a player has entered a number in the display, a player activates the reels by pulling the handle 20. If a winning combination of symbols or the number

14

combination entered by the player in the display 36 is indicated on the reels, the player wins an award. The award includes tokens and/or credits that are provided by the gaming device to the player. (Col. 2, lines 51-58). *Vasquez* does <u>not</u> disclose, teach or suggest providing an award having an amount that equals the number entered by the player in the display 36. Therefore, *Vasquez* does not disclose, teach or suggest an award determined by the processor wherein the amount of the award is based on the order of the numbers arranged by the player.

Similarly, the Price is Right pricing games include prizes that have predetermined values or amounts. A player plays a game to guess the predetermined price associated with a particular prize. If the player successfully guesses the price for a particular prize, the prize is awarded to the player. None of the Price is Right pricing games disclose, teach or suggest providing an award to a player, wherein the award amount <u>provided to the player</u> is based on the order of the masked numbers <u>arranged by the player</u>. In these games, the prices are predetermined and therefore are not determined by the player.

Moreover, the Price is Right pricing games are games where a player wins a prize when the player correctly guesses or matches every digit in the price of the prize. If the player incorrectly guesses one or more digits in the price, the player does not win the prize. Conversely in the claimed invention, the gaming device provides an award to the player, wherein the amount of the award is based on the numbers arranged by the player. If the player forms a three-digit number such as 1-0-5, the player wins one hundred five credits or coins. Similarly, if the player forms a two-digit number such as 0-1-5, the player wins fifteen credits or coins.

Therefore in comparison, the Price is Right pricing games provide the player with a prize when the player correctly guesses or determines all of the digits in the price of that prize. For example, If the player correctly guesses the price of a car as $10,500, the player wins the car. In the claimed invention, the player wins the value or amount indicated by the digits of the car such as ten thousand five hundred credits or coins.

In addition, in the Price is Right Pricing games, if the player correctly guesses four of the five digits in the price of the car such as $20,500, the player does <u>not</u> win the car because the player missed one of the digits in the price. In the claimed invention,

the player wins the value or amount indicated by the digits such as five hundred credits or coins. For all of these reasons, amended Claim 12 and Claims 13 to 29, which depend from amended Claim 12, are each patentably distinguished over *Vasquez* and the Price Is Right pricing games.

Additionally, Claims 23 to 28 were rejected under § 103(a). Claims 23 to 28 depend from amended Claim 12. Therefore, Applicants respectfully submit that Claims 23 to 28 are allowable for at least the reasons set forth above with respect to independent amended Claim 12, and for the further reasons that *Take Your Pick* fails to disclose, teach or suggest the novel elements of these claims in combination with the novel elements of independent amended Claim 12. For these reasons, Claims 23 to 28 are patentably distinguished over the combination of *Vasquez* and *Take Your Pick*.

Moreover, Claim 29 was rejected under § 103(a). Claim 29 depends from amended Claim 12. Therefore, Applicants respectfully submit that Claim 29 is allowable for at least the reasons set forth above with respect to independent amended Claim 12, and for the further reasons that *Hamano* fails to disclose, teach or suggest the novel elements of this claim in combination with the novel elements of independent Claim 12. For these reasons, Claim 29 are patentably distinguished over the combination of *Vasquez* and *Hamano*.

Amended Claim 30 is directed to a gaming device including a display device which displays a plurality of selections. The gaming device also includes a plurality of positions. A processor, which communicates with the display device, associates a plurality of numbers with the selections and enables the player to associate the selections with the positions. The processor causes the display device to display the numbers of the selections associated with the positions. The processor provides an award to the player wherein the amount of the award is based on the digit order of the numbers associated with the positions. For example, if the revealed numbers indicate a number 3-1-0, the amount of the award is three hundred ten and is provided to the player.

As described above, neither *Vasquez* nor the Price Is Right pricing games disclose, teach or suggest providing an award to the player wherein the amount of the award is based on the order of the numbers associated with the positions, which was

16

arranged by the player. These games provide independent values or awards such as a predetermined number of credits or tokens which are associated with the winning combinations in the games. For these reasons, amended Claim 30 and Claims 31 to 41 which depend from amended Claim 30 are each patentably distinguished over *Vasquez* and each of the Price is Right pricing games.

Additionally, Claims 38 to 41 were rejected under § 103(a) as being unpatentable over *Vasquez* in view of *Take Your Pick*. Claims 38 to 41 depend from amended Claim 30. Therefore, Applicants respectfully submit that Claims 38 to 41 are allowable for at least the reasons set forth above with respect to independent amended Claim 30, and for the further reasons that *Take Your Pick* fails to disclose, teach or suggest the novel elements of these claims in combination with the novel elements of independent amended Claim 30. For these reasons, Claims 38 to 41 are patentably distinguished over the combination of *Vasquez* and *Take Your Pick*.

Claim 42 is directed to a gaming device that includes a display device and a processor, which communicates with the display device. A plurality of selections are displayed by the display device. The gaming device also includes a selection orderer which communicates with the processor to enable the player to select and order at least two selections with digits to form an award. The processor reveals the award by displaying a number associated with each of the selection in the digit selected by the player.

On the contrary, *Vasquez* enables a player to input numbers in a display 36. However, the selection and order of those numbers in display 36 do not form the award which is provided to the player. Instead, *Vasquez* provides separate independent awards which are predetermined and assigned to the winning combinations in the game. Thus, the awards themselves in *Vasquez* are not based on the ordering of the numbers by the player in display 36. Similarly, as described above, the Price is Right pricing games generally enable a player to pick numbers which match numbers in the price of a prize. The price of the prize is predetermined and therefore the numbers associated with the positions in the prizes are fixed and determined prior to any selections made by the player. For these reasons, Claim 42 and Claims 43 to 46,

17

which depend from Claim 42, are each patentably distinguished over *Vasquez* and each of the Price is Right pricing games.

Claim 45 was rejected under § 103(a). Claim 45 depends from Claim 42. Therefore, Applicants respectfully submit that Claim 45 is allowable for at least the reasons set forth above with respect to independent Claim 42 because *Vasquez* does not disclose, teach or suggest the novel elements of Claim 45 in combination with the novel elements of independent Claim 42. For these reasons, Claim 42 are patentable distinguished over *Vasquez*.

Claim 47 is directed to a gaming device that includes a display device which displays a plurality of selections to a player. A processor, which communicates with the display device, associates numbers with the selections. The processor enables the player to associate selections with the one's digit and the ten's digit of an award which is provided to the player. Conversely, neither *Vasquez* nor any of the Price is Right pricing games disclose a game in which the player picks selections and a processor associates numbers based on the picked selections by the player with the one's digit and ten's digit in an award provided to the player. As described above, *Vasquez* and the Price is Right pricing games provide predetermined awards or prizes to a player when the player obtains a winning combination or a win in those games. For these reasons, Claim 47 is patentably distinguished over *Vasquez* and each of the Price is Right pricing games.

Claim 48 is directed to a gaming device including a display device which displays a plurality of selections to a player. A processor, which communicates with the display device associates numbers with the selections. The processor enables a player to associate the selections with a one's digit, a ten's digit and a hundred's digit in an award provided to the player. Thus, the player is determining the amount of the award provided to that player. Conversely, *Vasquez* and each of the Price is Right pricing games include predetermined awards or prizes which are provided to the player when the player obtains a winning combination or win in those games. Neither *Vasquez* nor the Price is Right pricing games disclose, teach or suggest enabling a player to pick selections and associating numbers with those selections to the one's digit, ten's digit and hundred's digit in an award which is provided to the player. For these reasons,

18

Appl. No. 09/934,003

Claim 48 is patentably distinguished over *Vasquez* and each of the Price is Right pricing games.

Amended Claim 49 is directed to a gaming device including a display device and a processor, which communicates with the display device. The gaming device also includes an initial determination of a number of possible digits for a player's award. A plurality of selections are displayed by the display device. The processor associates numbers with the selections and enables the player to associate the selections with the number of possible digits provided by the initial determination to form an award provided to the player. The amount of the award is based on the order of the digits. As described above, neither *Vasquez* nor any of the Price is Right pricing games disclose a game in which the award is based on the selections associated with the digits by the player. For these reasons, amended Claim 49 and Claim 50, which depends from Claim 49, are patentably distinguished over *Vasquez* and each of the Price is Right pricing games.
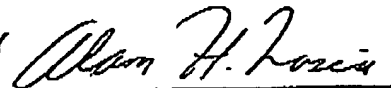
Attached hereto is a marked up version of the changes made to the claims by the present amendment. The attached page is captioned **"Version with markings to show changes made"**.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the Applicants' attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Respectfully submitted,

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19

Appl. No. 09/934,003

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

The paragraph beginning at line 6 of page 16 has been amended as follows:

Referring now to Figs. 3A and 3B, the game displays three selectable selections or masked numbers 116, namely, the "X," "Y" and "Z" selections or masked numbers 116. The selections or masked numbers 116 illustrated generally on the screen 400 130, as well as other inputs and indicators, preferably contain indicia that relate to a theme of the gaming device. The selections or masked numbers 116 hide numbers or digits that are revealed and become part of the player's award. That is, the player's award is based on the order of numbers or digits associated with the selections or revealed when the masked numbers are unmasked. For purposes of this application, "selections" and "masked numbers" are used interchangeably.

The paragraph beginning at line 23 of page 27 has been amended as follows:

The screen 400 145 can present any number of selectable inputs, such as inputs 102 through 108, and is not limited to presenting four as illustrated. The selectable inputs in one embodiment are areas of a touch screen 50 (see Fig. 2) in communication with the processor 38 and a touch screen controller 52. The inputs may alternatively be separate electromechanical input devices, mounted elsewhere on gaming device 10, which are in communication with the processor 38. A message 110 is visually displayed, audibly displayed through speakers 36 or both.

Appl. No. 09/934,003

In the Claims:

Claim 1 has been amended as follows:

1.   (Amended) A gaming device comprising:

a display device;

a plurality of player selectable positions displayed by the display device; and

a processor which communicates with the display device, which enables a player

to select the positions, which associates numbers with the positions based on the

player's <u>order of</u> selection of the positions and which determines an award <u>to be</u>

<u>provided to the player</u> based on an order of the numbers associated with the positions.

Claim 12 has been amended as follows:

12.   (Amended) A gaming device comprising:

a display device;

a plurality of masked numbers displayed by the display device;

a processor which communicates with the display device and enables a player to

arrange at least two of the masked numbers in an order decided by the player; and

an award determined by the processor and provided to the player, <u>wherein the</u>

<u>amount of the award is</u> based on the order of the masked numbers arranged by the

player.

Appl. No. 09/934,003

Claim 30 has been amended as follows:

30.   (Amended) A gaming device comprising:

a display device;

a plurality of positions;

a plurality of selections displayed by the display device; and

a processor which communicates with the display device, which associates a plurality of numbers with the selections, which enables a player to associate the selections with the positions, which causes the display device to display the numbers ~~associated with~~ of the selections ~~that have been ordered in association~~ associated with the positions, and which ~~determines the~~ provides an award to the player, wherein the amount of the award is based on ~~which is~~ the digit order of the numbers associated with the positions.

Appl. No. 09/934,003

Claim 49 has been amended as follows:

49.   (Amended) A gaming device comprising:

an initial determination of a number of possible digits for a player's award;

a display device;

a plurality of selections displayed by the display device; and

a processor which communicates with the display device, which associates numbers with the selections, and which enables the player to associate the selections with the number of possible digits provided by the initial determination to form an award provided to the player wherein the amount of the award is based on the order of the digits.